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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
GANESAN, et al. : Art Unit: 3627  
Serial No: 09/298,889 :  
Filed: April 26, 1999 :  
Examiner: E. Gort

For: ELECTRONIC BILL PRESENTMENT AND/OR PAYMENT CLEARINGHOUSE

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

July 30, 2004

Sir:

This Reply Brief is submitted (in triplicate) in response to the Examiner's Answer issued on June 6, 2004.

**REPLY TO EXAMINER'S RESPONSE TO ARGUMENTS**

It is first noted with appreciation that the Examiner has withdrawn the indefiniteness rejection of claims 7, 8, 12-14, 17, 22, 23, 26, and 27 under 35 U.S.C. §112, second paragraph, in view of the Appeal Brief filed on December 9, 2003. All arguments from the Appeal Brief relating to the rejections under the prior art are incorporated herein, though for the sake of brevity they are not repeated in their entirety.

In the Appeal Brief it is argued that the applicants have been deprived of their rights to due process under the law. In particular, a clear issue has never been reached with respect to the rejection of the claims because of the Examiner's failure to properly consider

detailed arguments presented in traversal of the prior art rejections, and failure to provide any reasonable or understandable basis for the rejection.

The Examiner's Answer states that it is "unclear from the Appellant's Due Process argument what arguments specifically have not been addressed." It is respectfully submitted that, as evidenced by the record, the Official Action of July 18, 2003 fails to address any traversal arguments relating to the rejections under the prior art. The extent of the Examiner's response to traversal arguments consists of the statement "Applicant's arguments filed 6/16/03 have been fully considered but they are not persuasive" and a reference to the detailed rejection "regarding clarification".

Specific traversal arguments contained in the June 13, 2003 Amendment that the Examiner failed to address include:

- 1) The electronic check of Chang is not a directive to transfer funds to a deposit account, contrary to the Examiner's contention, as argued on page 6, first full paragraph, of the June 13, 2003 Amendment;
- 2) Chang does not disclose a central database that stores remittance information, and does not have need for such a database, as argued in the paragraph bridging pages 6 and 7 of the June 13, 2003 Amendment; and
- 3) There is nothing in Chang to teach or suggest that a payee transmits a request to access stored remittance information, as argued in the third full paragraph of page 7 of the June 13, 2003 Amendment.

Had the Examiner responded to the above, and other, arguments by providing reasonably understandable arguments rebutting the traversal an issue would have been reached. However, the Examiner has not addressed detailed traversal

arguments and has simply maintained positions which cannot be reasonably understood or supported. Thus, the issues in this case remain unfocused and the basis for rejection remains unclear. Accordingly, it is again asserted that applicants have been deprived of their rights to due process under law.

In the Appeal Brief it is also argued that the Examiner has failed to establish a *prima facie* case, and that the applied reference (Chang) fails to teach or suggest the claimed invention.

In responding to the Appeal Brief argument that the electronic check disclosed by Chang is not a directive to transfer funds to a deposit account, as required by the independent claims of the present application, the Examiner argues that this limitation is met "when the electronic check of Chang is created, retrieved by and transmitted to the payee to be endorsed and electronically deposited into the Payee's Bank (see figure 5 and column 4 lines 52+). Examiner has taken the definition of a directive to be "something that serves to direct, guide, and impel toward an action or goal" ... an electronic check forwarded to a payee serves to direct, guide and impel the associated funds toward an action or goal (payee's bank account). All the actions taken in generating the electronic check with envelope and processing carried out until the funds are finally transferred into the payee's account serve "to direct, guide and impel" a transfer of funds to the payee's account and thus constitute the generation and transmission of a "directive" to transfer funds to a deposit account."

Contrary to the Examiner's position, Chang's electronic check does not "direct, guide, and impel toward an action or goal." Chang's electronic check is just

that, a check in electronic form. It does not direct toward any action or goal, it does not guide toward any action or goal, and it does not impel toward any action or goal. Rather, Chang's electronic check must be delivered to the check's payee, the payee must then deposit the electronic check with his or her bank, and the payee's bank must then settle the electronic check with the payor's bank, all as discussed in the Appeal Brief. Thus, several actions must be taken before funds eventually enter the payee's bank account based upon Chang's electronic check, just as several actions must be taken before funds eventually enter a payee's bank account based upon a conventional paper check. These actions are in no way directed, guided, or impelled by Chang's electronic check. Indeed, it should be noted that, if a payee so chooses, Chang's electronic check might never be deposited, and thus funds would never enter the payee's bank account.

Furthermore, the presently claimed directive is required to direct a transfer of funds into a payee's deposit account. As will be recognized by one of ordinary skill in the art, Chang's electronic check, as well as a conventional paper check, at most identifies an account to be debited during settlement, i.e., after depositing. Chang's electronic check, as well as a conventional paper check, simply does not identify an account to which to transfer funds to, i.e., a payee's account. Thus, Chang's electronic check cannot be a directive to transfer funds to a payee's deposit account.

In view of arguments presented throughout prosecution, in the Appeal Brief, and above, it should be clear that the electronic check disclosed in Chang, contrary to the Examiner's assertions, is not a directive to transfer funds to a deposit

account, as required by the independent claims of the instant application. Thus, for this reason alone, the rejection of the independent claims is improper. However, the rejection of the claims is improper for other reasons as well.

As discussed throughout prosecution and in the Appeal Brief, independent claim 7 of the instant application requires, *inter alia*, a processor configured to generate remittance information associated with a payment, to receive a request to access the remittance information (which is stored in a central database), to retrieve the remittance information stored in the central database, and to transmit the retrieved remittance information. Independent claim 14 requires, *inter alia*, a central network station configured to generate remittance information associated with a payment, to store the remittance information, to receive a request to access the stored remittance information, to retrieve the stored remittance information, and to transmit the retrieved remittance information. Independent claim 29 requires, *inter alia*, a central network station configured to generate remittance information associated with a payment, a central database configured to store the generated remittance information, and payee network station configured to transmit a request to access the stored remittance information, and to receive the stored remittance information in response to the request.

Thus, each of the independent claims requires generation of remittance information associated with a payment, or payments, storage of the generated remittance information, and payee request(s) to access the remittance information.

Regarding the generation and storage of remittance information, the Examiner argues in the Answer that in Chang “[r]emittance information is generated

and contained within the electronic check (for example remittance information includes the payment amount and payor's identification) which is later stored in an electronic envelope at the payee's designated routing destination for the payee to later access and process both the check and the remittance information."

As argued in the Appeal Brief, Chang discloses that the electronic check includes limited remittance information that is based upon billing information supplied by a biller (payee) to a payor's bank. In other words, the electronic check includes information that was included in the billing information. This information is not associated with a payment, as required by the present claims, but rather is associated with the billing information.

Also as argued in the Appeal Brief, the billing information-associated limited remittance information of Chang included in the electronic check transmitted to the payee. The payee does not request the transmission of the electronic check. Thus, Chang lacks any need for, and hence lacks any disclosure of, the required generation of remittance information associated with a payment and storage thereof.

In the Examiner's Answer it is argued that Chang's electronic check "is stored within the electronic envelope which is forwarded and stored at the payee's designated computing system routing destination (see column 10 lines 1-6) ... for the payee to later access and process both the check and the remittance information." The Examiner-referenced text discloses transmission of an electronic check in an electronic envelope to a computing system of a payee. The referenced text does not teach or suggest storage of Chang's electronic check, let alone

storage of generated remittance information. Rather, it only discloses transmission to the payee's computing system. What happens at the payee's computing system subsequent to the transmission is entirely speculative. Again, because Chang pushes the electronic check to the payee (i.e., transmits it to the payee without a payee request for such), Chang lacks any need for, or disclosure of, storage of any remittance information.

The Appeal Brief also includes argument directed to Chang lacking the required payee request for access to remittance information. The Examiner contends "this is done inherently when the payee requests to view the electronic checks stored at the payee's designated computing system routing destination, or "central database", in order for the payee to processes [sic] them for depositing (see column 10 lines 1-6). In order for the payee to view the electronic checks on their computer screen a request must be sent to their storage location in order for the system to send the stored electronic checks from the location they are saved at."

First, as discussed above, Chang does not disclose storage of an electronic check at a payee's system. Thus, Chang necessarily lacks, and in fact does lack, any disclosure relating to a payee's request to retrieve a stored electronic check. Again, in Chang electronic checks are pushed to a payee (i.e., without a payee request for such), not pulled by a payee (i.e., not requested by a payee). Secondly, and perhaps more importantly, even if Chang did disclose storage of an electronic check at a payee's system and a payee request for retrieval of a stored electronic check (which it does not), such a request would not read upon the present claims,

as the present claims require a request for remittance information, not a request for an electronic check.

Still further, independent claims 7 and 14 require, *inter alia*, that a single processor (claim 7) or central network station (claim 14) receive an instruction to make a payment, generate remittance information, receive a request to access the remittance information, retrieve the remittance information, and transmit the retrieved remittance information. It is respectfully submitted that Chang in no way can be read as disclosing such. Chang requires, as discussed in the Appeal Brief, a payor's bank receiving a payment instruction and generating and transmitting to a payee's computing system an electronic check in response thereto. If a payee's computing system receives a request to access remittance information, retrieves the remittance information, and transmits the retrieved remittance information, as argued by the Examiner, Chang necessarily does not read upon the present claims, as the payee's computing system can in no way be read to receive an instruction to make the payment with which the electronic check is associated. The Examiner's own arguments clearly lead to the conclusion that these independent claims are not taught or suggested by Chang.

Dependent claim 8, 22, 23, and 31 require that a processor or central network station generating a directive transmit the directive to a financial institute. As argued in the Appeal Brief, Chang simply does not disclose that an electronic check (which the Examiner, mistakenly, equates with a directive) is transmitted to a financial institute. Rather, as discussed above, Chang's electronic check is

transmitted to a payee's computing system, and the Examiner acknowledges such in the Examiner's Answer.

In arguing that Chang reads upon claims 8, 22, 23, and 31, in the Examiner's Answer, the Examiner again reasons, "[t]he payee's bank is a financial institute. ... All the actions taken in generating the electronic check with envelope and processing carried out until the funds are finally transferred into the payee's account serve "to direct, guide and impel" a transfer of funds to the payee's account and thus constitute the generation and transmission of a "directive" to transfer funds to a deposit account."

As can best be understood, the Examiner seems to be arguing that the act of a payee depositing an electronic check of Chang with his or her bank somehow meets this limitation. The plain language of the claims makes it clear that the entity receiving a payment request and generating a directive must transmit that directive to a financial institute. The claim can in no way be properly construed to require that the transmission to the financial institute be made by the payee.

Claim 12 requires a central database configured to store both generated remittance information and billing information. Further, the central database must be configured such that the stored remittance information is accessible by one network station representing a payee, and that the stored billing information is accessibly by another network station representing a payer.

As argued in the Appeal Brief, at best Chang discloses a database at a payor's bank for storing a bill received from a payee for presentment to the payor. Chang does not disclose a database storing remittance information, as discussed

above. The Examiner argues in the Answer that the payee's computing system stores remittance information (contained in the electronic check) and thus corresponds to the recited central database. However, the Examiner has failed to address the requirement that the central database also store the billing information, and that the billing information be for another payor different than the payor having requested the payment. As should be understood from the paragraph above, Chang simply does not teach or suggest such. Further, how the payee's computing system could be read to read upon the requirements of claim 12, including the central database (which the Examiner contends is the payee's computing system) storing billing information for one entity and remittance information for another entity, cannot reasonably be understood.

Claim 13, which depends from claim 12, requires that the processor which accesses the remittance information at the request of a first payee also be able to access the billing information at the request of a second payor, and additionally, to transmit the accessed remittance information to the first payee and the accessed billing information to the second payor.

The Examiner looks to Figure 2 in support of the rejection in the Answer and argues "Chang discloses a system which processes access to remittance information for multiple payees and also processes access to billing information for multiple payors and therefore discloses a processor capable of performing these functions. See figure 2 showing multiple payor and payees obtaining processed requests from the Chang system." The Examiner fails to point to any portion of Chang's written description in support of this position.

It is respectfully submitted that all Figure 2 discloses is multiple payors and payees in communication with a bank computing system. As discussed in the Appeal Brief, Chang discloses a system whereby a bank presents bills to payors on behalf of payees, and receives payment requests from the payors. The Examiner's position is not understood, especially in light of the Examiner's arguments regarding the payee's computing system vis-à-vis remittance information. What is shown in Figure 2 is a bank computing system, not a payee's computing system. Thus, the Examiner's position is not clear: The question must be asked, is the Examiner now arguing that a bank computing system receives a request for remittance information and transmits the same? Again, the Examiner's position cannot be reasonably understood.

As argued in the Appeal Brief, regarding claims 17 and 30, Chang does not store remittance information, let alone remittance information having different information segments, each segment associated with payment to a different one of a plurality of payees, and storage of the remittance information so as to be accessible to a particular one of a plurality of network stations associated with a particular user.

In the Answer the Examiner now argues that Chang, at column 7, line 14, discloses the requirements of claims 17 and 30. In particular, the Examiner argues that such is disclosed "when it [Chang] discusses the instances for single electronic bills designating two or more payees with separate payment to each payee (integrated bills) where two or more companies are providing services but bill

together, each electronic check sent to the payee's would include [sic] remittance information with different information segments."

The Examiner's position is again not understood. In other portions of the Examiner's Answer, discussed above, the Examiner argues that required remittance information is included in an electronic check delivered to a payee, and that the required request to access the remittance information is a request to view an electronic check already delivered to a payee's computing system. The relied upon text, column 7, line 14, discloses that in those cases where an electronic bill identifies two payees, each of the two payees will receive a separate electronic check, and the Examiner acknowledges such. Thus, how a single payee's computing system, which the Examiner equates with the recited central network station, could possibly meet the limitations of claims 17 and 30 that the remittance information stored at the central database include remittance information for multiple payees is simply not understood.

With regard to claims 26, 27, and 32, claim 32 requires that the processor be further configured to transmit the directive to transfer funds after the receipt of the request to access the remittance information, claim 27 requires that the central network station be further configured to generate each of the directives to transfer the funds in payment of a particular one of the bills to which that directive relates only after the receipt of the request to access the remittance information associated with the payment of that particular bill, and claim 32 requires the central network station to be further configured to direct transmission of generated directives only after the

one payee has transmitted a request to access a stored information segment associated with those payments made to the one payee.

Simply put, these claims require that a payee request for access to remittance information associated with a payment be received **before** a directive to transfer funds in making that payment is transmitted. Chang in no way teaches or suggests such. As discussed above, in Chang an electronic check is pushed to a payee. There is no payee request at all for an electronic check, let alone a request for remittance information.

The Examiner argues in the Answer "Chang does disclose the processor being configured to transmit the directive after the receipt of the request to access the remittance information. As the payee must view the electronic check and endorse it in order to make the deposit, the processor is configured to transmit the directive to the payee only after the payee requested to access the electronic check which includes the remittance information."

As discussed above, the Examiner's contention that an electronic check being transmitted to a payee's computing system reads upon the required request for access to stored remittance information is faulty for several reasons. Further, these claims clearly require that the transmission of the directive be a separate transmission from the transmission of the remittance information. According to the Examiner's own argument, the transmission of the electronic check and remittance information is a single transmission, as the remittance information is included in the electronic check. Thus, following the Examiner's own logic, Chang necessarily does not teach or suggest that required by claims 26, 27, and 32.

In view of the above, it is again respectfully submitted that the Examiner has denied applicants their due process rights under the Constitution of the United States of America, failed to establish a *prima facie* case for the rejections, failed to apply art which teaches or suggests the claimed invention, and has failed to reasonably construe that which is taught and suggested by the applied art.

Thus the rejection of the pending claims is in error, and reversal is clearly in order, and is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1158.41323X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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